

REMARKS

Claims 2-10 are pending in the application. Applicants respectfully requests reconsideration in view of the Remarks submitted herewith.

Claims 2-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Prior Art figures 5 and 6 in view of Yamada et al. (US 6,072,450) ("Yamada"). For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 2 includes the following limitation: "a detector in contact with the display surface of said display device for detecting an emissive state of a display pixel at the position of contact, wherein said plurality of display pixels to emit light in a predetermined sequence for obtaining coordinate information of the position of contact of the detector." Claim 3 includes the following limitation: "a pen for contacting the display surface of said display and for detecting the emissive state of the display pixel at the position of contact * * * a digitizing processing circuit for generating coordinate information on the basis of change in detection output of said pen with respect to timing of horizontal scanning and vertical scanning of said display control circuit." These claims require that the detector or pen is used to detect the emissive state and that coordinates are determined on the basis of the detection state of the detector or pen and the light emitting timing of the display. None of the references teach or suggest the combination of those limitations.

The Examiner has indicated that "Prior Art Figures 5-6 disclose that a digitizing apparatus for obtaining coordinate information (14), and display control circuit (13) for displaying an image on the display by determining timing [of] horizontal scanning and vertical scanning." This statement is incorrect.

Prior art figures 5-6 do not disclose a display control circuit for displaying an

image on the display by determining timing of horizontal and vertical scanning. Page 2 of the specification discloses that the display control circuit 13 generates the horizontal synchronization signal HD and the vertical synchronization signal VD in synchronous with the picture signal Y, and supplies the picture signal Y, the horizontal synchronization signal HD, and the vertical synchronization signal VD to the flat display 11. Also, the coordinate processing circuit 14 is connected to the resistance sheet 12, and detects on the basis of the resistance value R that is input from the resistance sheet 12 the coordinate of the position receiving pressure on the resistance sheet 12. There is nothing in the prior art figures 5-6 that discloses the determining of the timing of horizontal and vertical scanning. Accordingly, the Examiner's assertion is incorrect as to the teachings of prior art figures 5-6.

In addition, the Examiner states that figures 5-6 do not disclose "that a digitizing comprising a light emitting display device having a plurality of display pixels disposed in a matrix and a detector in contact with the display surface of the display device, wherein the plurality of display pixels to emit light." The Examiner then asserts that Yamada discloses "in figures 7 and 16 a light emitting display device having a plurality of display pixels (EL element 3) disposed in a matrix and a detector in contact with the display surface of the display device, wherein the plurality of display pixels to emit light." The Examiner points to column 10, lines 48-67. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching as taught by Yamada using the light emitting display device having a plurality of display pixels in the device disclosed in prior art figures 5-6 because this would emit light at the luminance according the applied voltage. Applicants respectfully traverse.

According to the prior art figures 5-6, the display 11 is only for normal displaying function and coordinates are detected by a resistance sheet 12 provided to sense the position touched by the pen 5. See page 2, lines 8-23 of the Applicants' specification. Moreover, Yamada merely discloses an EL display and does not teach or suggest using a detector or a pen. When analyzing prior art figures 5 and 6, there is a resistance sheet used in order to recognize the coordinates on the display surface. It would not be obvious to one skilled in the art would not how to combine prior art figures 5 and 6, which requires

the use of a resistance sheet to determine the coordinates, with Yamada in which there is no need for the resistance sheet. Moreover, because Yamada does not teach or suggest using a pen or detector, one skilled in the art would not have thought to use a pen or detector with the display device disclosed in Yamada.

As such, there is no motivation to combine Yamada with any prior art that utilizes a detector or a pen. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP § 2143.01. As explained above, Yamada merely discloses an EL display and does not teach or suggest using a detector or a pen. Moreover, one skilled in the art would not have thought to use a detector or a pen. Accordingly, one skilled in the art would not combine Yamada with Prior Art figures 5 and 6 because there is no motivation to do so.

Applicants submit that the motivation for the limitations quoted above come from Applicants' disclosure. Applicants maintain that the Examiner has used an improper standard in arriving at the rejection of the above claims. In applying Section 103, the U.S. Court of Appeals for the Federal Circuit has consistently held that one must consider both the invention and the prior art "as a whole," not from improper hindsight gained from consideration of the claimed invention. See *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and cases cited therein. According to the *Interconnect* court

"[n]ot only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time - a technician without our knowledge of the solution." *Id.*

In this case, the Examiner does not point to any reference that provides the teaching as to the above quoted limitations. Applicants submit that when AAPA and Yamada are applied in context, a person skilled in the art would not arrive at Applicant's claimed limitations.

Thus, claims 2 and 3 are patentable over Prior Art Figures 5 and 6 and Yamada. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection as to claims 2 and 3.

Claims 4-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Prior Art figures 5 and 6 in view of Yamada et al. (US 6,072,450) and Tomio et al. (US 5,745,085). For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

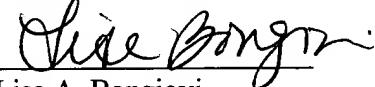
As explained above, Prior Art Figures 5 and 6 and Yamada do not teach or suggest that the pen is used to detect the emissive state and that coordinates are determined on the basis of the detection state of the pen and the light emitting timing of the display, as required by claim 4. Moreover, Tomio does not remedy this deficiency; thus, the references do not teach or suggest all of the limitations of claim 4. Claims 5-10 include all of the limitations of claim 4. Thus, Prior Art Figures 5 and 6, Yamada, and Tomio do not teach or suggest all of the limitations of claims 5-10. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection as to claims 4-10.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

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